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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,614	03/12/2001	Peter Heffernan	5181-80000	3156

7590 07/13/2004

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EXAMINER

PATEL, NIKETA I

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 07/13/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,614

Applicant(s)

HEFFERNAN, PETER

Examiner

Niketa I. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 15-22 is/are rejected.
- 7) ☒ Claim(s) 7-14 and 23-30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.6
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

2. Claims 7-14 and 23-26 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claims 4 and 20. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 27-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 27-30 rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point

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out what is included or excluded by the claim language.

This claim is an omnibus type claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4 and 15-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Experton U.S. Patent Number: 5,995,965 (hereinafter referred to as "*Experton*".)

7. **Referring to claim 1**, *Experton* teaches a processing unit connectable to a data communications network [see column 8 - lines 22-35], said processing unit having a data carrier reader operable to read a network address from a hand insertable data carrier [see column 8 - lines 36-51], wherein said processing unit is operable to use said network address from said data carrier for communicating via said data communications network [see column 8 - lines 22-51.]

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8. **Referring to claim 2**, *Experton* teaches a processing unit comprising a memory unit operable to store a first network address for use in communicating via said network, said processing unit being operable to determine whether said data carrier is present in said reader, said processing unit being operable to use said network address from said data carrier, if the data carrier is present in said reader and otherwise to use said first network address [see column 8 - lines 22-51.]

9. **Referring to claim 3**, *Experton* teaches a processing unit wherein said processing unit uses said network address from said data carrier only when said network address is present in said carrier reader [see column 8 - lines 22-51.]

10. **Referring to claim 4**, *Experton* teaches a processing unit comprising a read/writeable register, wherein said processing unit is operable to write said network address into said register read from said data carrier by said data carrier reader and to use said network address read from said register for communicating via said network [see column 8 - lines 22-51.]

11. **Referring to claim 15**, *Experton* teaches a method of operating a computer system comprising: connecting a processing unit to a communications network, said processing unit having a data carrier reader [see column 8 - lines 22-51]; loading a data carrier into said data carrier reader, said data carrier having

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recorded thereon a network address for use in communicating via said network [see column 8 - lines 22-51]; arranging for said network address to be read from said data carrier [see column 8 - lines 22-51]; and arranging for said processing unit to use said network address read from said data carrier to communicate via said network [see column 8 - lines 22-51.]

12. **Referring to claim 16**, *Experton* teaches a method wherein said processing unit is replaceable, and the step of connecting a processing unit to a computer network comprises disconnecting a first processing unit from said communications network, and connecting a second replacement processing unit to said communications network in place of said first processing unit [see column 8 - lines 22-51.]

13. **Referring to claim 17**, *Experton* teaches a device for use in a computer system, said device being connectable to a data communications network, said device having a data carrier reader operable to read a network address from a hand insertable data carrier, wherein said device is operable to use said network address from said data carrier for communicating via said data communications network [see column 8 - lines 22-51.]

14. **Referring to claim 18**, *Experton* teaches a device, comprising a memory unit operable to store a first network address for use in communicating via said network, said device

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being operable to use said network address from said data carrier, if said data carrier is present in said reader and otherwise to use said first network address [see column 8 - lines 22-51.]

15. **Referring to claim 19**, *Experton* teaches a device, wherein said device uses said network address from said data carrier, only when said network address is present in said carrier reader [see column 8 - lines 22-51.]

16. **Referring to claim 20** *Experton* teaches a device, comprising a read/writeable register, wherein said device is operable to write said network address into said register from said data carrier reader and to use said network address read from said register for communicating via said network [see column 8 - lines 22-51.]

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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18. Claims 5-6 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Experton U.S. Patent Number: 5,995,965 (hereinafter referred to as "*Experton*".)

19. **Referring to claims 5-6 and 21-22** *Experton* teaches a processing unit connectable to a data communications network [see column 8 - lines 22-35] however does not set forth the limitation of a processing unit comprising a register flag operatively associated with said read/writeable register, wherein said processing unit is operable to set said flag once said network address has been read from said data carrier, and thereafter to interrogate said flag and to use said network address read from said register if said flag is set, wherein said processing unit is operable to read said first address from said memory unit if said flag is not set.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention that it was old and well known in the computer art to get the advantage of being able to select either of the memories by setting a flag once a network address has been read from a smart card. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to set a flag once a network address has been read from a smart card to get this advantage.

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Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following documents have been made record of to further show the state of the art as it pertains to smart card with a network address:

Caspers et al. U.S. Patent Number: 6,651,110

Wall et al. U.S. Patent Number: 6,223,289

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niketa I. Patel whose telephone number is (703) 305 4893. The examiner can normally be reached on M-F 8:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (703) 308 3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NP
07/06/2004



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